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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/719,639	09/25/1996	SHANE D. MATTAWAY	N0003/7013	9685

7590

09/18/2002

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EXAMINER

HSU, ALPUS

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 09/18/2002

34

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/719,639

Applicant(s)

MATTAWAY ET AL.

Examiner

Alpus H. Hsu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The request filed on July 11, 2002 for a Request for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 08/719,639 is acceptable and a RCE has been established. An action on the RCE follows.

2. In the entire specification, the applicant is requested to update the status from time to time for all of the listed related co-pending applications.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The newly claimed feature of “the telephony processes having a dynamically assigned protocol address” as in claims 1, 12, 23 and 31 does not have proper antecedent basis in the disclosure.

4. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 1, 12, 23 and 31, it is unclear as to how the telephony processes can have a dynamically assigned protocol address. In conventional art, it is within the header of a packet can have an assigned protocol address, such as IP address.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>®</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 12, 23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberlander et al. in U.S. Patent No. 5,825,865 in view of Gordon in U.S. Patent No. 5,608,786 (both of records).

By broadly interpreting the message including message descriptor transmitted as the claimed call packet, and the network (101) processing the message utilizing controller (or computer) and databases as the claimed packet-switched computer network, Oberlander et al. discloses a method, apparatus and computer program product for selectively alerting user of an incoming communication over a packet-switched computer network (101, 104 and 106) by receiving an incoming communication containing an information profile (Fig. 3) identifying the source of the incoming communication, and responding to the incoming communication in accordance with the identity of the source, providing source physical address or telephone number in the information profile (see Figs. 1-5, col. 3, line 33 to col. 8, line 50) as in claims 1, 12, 23 and 31.

Oberlander et al. fails to disclose the feature of having call packets generated from telephony processes, which have dynamically assigned protocol addresses as claimed. But Oberlander et al. does disclose the call packets can be of the types of paging message, FAX message, ISDN message and/or E-Mail. It is also well known in the art for routing these messages via Internet, providing these messages to include IP addresses in the header. Gordon, from the similar field of endeavor, provides the teaching of routing paging message, FAX message, ISDN message and/or E-Mail via Internet with each of these messages including IP addresses in the header, which can be easily adopted by one of ordinary skill in the art to implement in the system of Oberlander et al. to increase the system flexibility and performance.

6. Claims 2-11, 13-22, 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberlander et al. in view of Gordon, as applied to claims 1, 12, 23 and 31, and further in view of Blonder et al. in U.S. Patent No. 5,708,422 (all of records).

Considering claims 2-8, 13-19, 24-30, the system provided from the teaching of Oberlander et al. in view of Gordon does not teach the generation of a notification signal, nor its association with the information profile. Blonder et al. teaches a method and apparatus for using a communication system to alert a transaction user by including a database for receiving information and storing a profile, including a processor for retrieving the profile from the database and comparing information associated with the profile, and a network, over which a notification signal is transmitted (see Fig. 1, col. 5, lines 33-47, col. 7, lines 21-39). It would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the invention of Oberlander et al. to include the notification signal found in the teaching of Blonder et al. because of the advantage that it allows the system to be equipped with device for

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notifying the user and accommodates a wide variety of communication platforms, and allows the user to better control reception of incoming messages to best suit their own particular needs (see Oberlander et al., col. 2, lines 11-16).

Considering claims 9-11, 20-22, the combination of system and method provided from the teaching of Oberlander et al. in view of Blonder et al. fails to teach a notification signal as being an audio signal, a graphic image signal or a haptic sensor signal. The examiner takes Official Notice that the concept and the advantage of providing a notification signal which includes an audio signal, a graphic image signal or a haptic sensor signal are well known and expected in the art. It would have been obvious to include audio signal, graphic image signal or haptic sensor signal to the notification signal provided from the teaching of Oberlander et al. in view of Blonder et al. since the audio, graphic image signal and haptic sensor signal are known to provide the user with auditory, visual and sensible feedback to the communication system for user alerting purpose.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Norris et al. is additionally cited to show the feature of call notification via Internet utilizing IP addresses similar to the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (703)305-4377. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

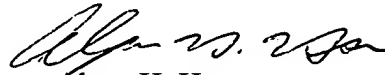
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (703)308-6602. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.

AHH  
September 16, 2002

  
Alpus H. Hsu  
Primary Examiner  
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